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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,862	11/24/2003	Timothy J. Taylor	29475/39204	5172
48995 7590 03/28/2008 MARSHALL, GERSTEIN & BORUN LLP (DIAL) 233 S. WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER				
OGDEN JR, NICHOLUS				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,862

Applicant(s)

TAYLOR ET AL.

Examiner

Necholus Ogden

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3, 5, 6, 9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-3, 5-6, 9, 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. Claims 11-12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of applicant's amendment.

1. Claims 2-3, 5-6, 9, 11-26 are rejected under 35 U.S.C. 103(a) as obvious over Beerse et al (6,294,186).

Beerse et al disclose an antimicrobial composition that is effective again Rhinoviruses and E-coli bacteria (col. 2, lines 1-10). Moreover, said composition comprises 0.01 to 20% by weight of a benzoic acid analog such as salicylic acid (col. 6, lines 20-33); water as a carrier (col. 9, lines 28-31); alcohol such as dihydric alcohols, isopropanol, ethanol or dipropylene glycol (col. 9, lines 44-55); and a pH of 2-4 with sodium hydroxide pH adjusting agents (col. 19, lines 24-35). Note, see examples 4, 12, 14-15, 16-18.

Beerse et al is silent with respect to the log reduction of at least 3 for 30 seconds.

It would have been obvious to one of ordinary skill in the art to expect the compositions of Beerse et al to exhibit efficacy against bacteria with a log 3 reduction for 30 seconds because Beerse et al teach compositions that maintain a log 2 reduction against viruses for 30 minutes to an hour and the artisan of ordinary skill would expect the compositions of Beerse et al to exhibit a greater reduction in a shorter interval of time, in the absence of a showing to contrary. Moreover, the compositions of Beerse et al teach the same ingredients as claimed for the purpose of making an antimicrobial

composition, wherein the artisan of ordinary skill would reasonably expect similar characteristics.

2. Claims 2-3, 5-6, 9, 11-19, 22, 25-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Hei et al (2002/0168422) is withdrawn in view of applicant's amendment.

Response to Arguments

3. Applicant's arguments filed 1-14-2008 have been fully considered but they are not persuasive.

4. Applicant argues that Beerse et al teach that the addition of a metal-acid complex acts as an additional anti-microbial agent.

5. The examiner contends that applicant's claims are bound by the transitional phrase of "comprising which permits the inclusion of additional components not specified in the claim. Moreover, as stated by applicant", Beerse et al do not require metal-salts in all of the embodiments and specifically suggest that the embodiments free of metal salts are effective in provide residual anti-viral efficacy (col. 47, lines 18-55) Therefore, Beerse et al do not require a metal-salt component as suggested by applicant, and further applicant's claims permit the use of additional ingredients not specified. Accordingly, the skilled artisan would therefore view embodiments without metal salts as permissible in light of the disclosure.

6. Applicant argues that Beerse et al fail to suggest a surfactant having 0 to 0.2%; and 5 to 50% by weight of a hydric solvent.

7. The examiner respectfully disagrees and directs applicant's attention to column 27, lines 55-60, which teaches less than 10% by weight of surfactants are needed. With respect to the hydric solvent, Beerse et al teach that said solvent is present in an amount from 0-95% (col. 9, lines 44-55).
8. Applicant argues that example 21 does not comprise a metal-salt but also does suggest high levels of surfactants.
9. The examiner contends that a reference does not need to teach each of the components in an example to be indicative of obviousness. The general teaching of Beerse et al states that metal –salt complex is not require to perform as suggested (col. 47, lines 18-55). Moreover, Beerse et al teach several embodiments that do not require surfactants (see examples 4, 12, 14-15, 16-18). Accordingly, the claims are not anticipated and therefore specific teachings of preferred embodiments are not strictly adhered to.
10. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).
11. Applicant suggests comparative examples 2 and 3 of his specification for proof of unexpected results.

The examiner contends that criticality cannot be established because applicant has not compared the closes prior art with the claimed invention. Moreover, said comparative examples are not commensurate in scope with the claimed invention or the

prior art of record. Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In *re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. In *re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In *re Merchant*, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978).

Applicant suggests that the rejection is made based on a cherry picking ingredients for support and specifically the statement excluding the metal salt complex.

The examiner contends that the general teaching of Beerse et al states that metal –salt complex is not require to perform as suggested (col. 47, lines 18-55).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Necholus Ogden/
Primary Examiner

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3-25-2008